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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/875,208 | 06/06/2001 | Yoichi Okudera | 3620-P02590US0 | 6076 |
| 110 | 7590 | 11/30/2004 | EXAMINER | |
| DANN, DORFMAN, HERRELL & SKILLMAN 1601 MARKET STREET SUITE 2400 PHILADELPHIA, PA 19103-2307 | | | COLLINS, SCOTT M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2145 | |

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|----------------------------------------|--|
| Office Action Summary | Application No. 09/875,208 | Applicant(s) OKUDERA, YOICHI | |
| | Examiner Scott M. Collins | Art Unit 2145 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-41 examined.
2. It is hereby acknowledged that the following papers have been received and placed of record in the file: Foreign Priority Papers on 07/09/2001 and an Information Disclosure Statement on 01/15/2002.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-41 rejected under 35 U.S.C. 102(e) as being anticipated by Tsuei.

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6. Referring to claims 1, 8-10, 23-26, Tsuei has taught an address inquiry system for informing an inquirer of a new address of a user based on an old address of the user via an Internet (Tsuei figure 3), comprising:

a. a database relationally storing at least the old address, the new address, and an address disclosing condition capable of setting a condition whereby the user decides whether to give permission to disclose the new address (Tsuei figure 3, elements 340, 342, 344, 350, 352, and 354)

b. a means for searching the new address corresponding to the old address and the address disclosing condition from the data base when the inquirer sends an inquiry including the old address (Tsuei column 6, lines 20-29);

c. a means for making the user confirm whether the new address is disclosed when the address disclosing condition in searching includes the set condition (Tsuei figure 3, elements 350, 352, and 354; and column 6, line 66 – column 7, line 8); and

d. a means for informing the inquirer of the new address when the user permits the disclosure of the new address (Tsuei column 7, line 19 – column 8, line 4 includes multiple means for accomplishing this task.).

7. Referring to claims 2, 11-12, 35, Tsuei has taught the address inquiry system wherein the data base includes inquirers who are refused a list of specific inquiries about the new address, the system, further comprising a means for refusing an inquiry from the inquirer included in the list (Tsuei column 6, lines 55-65).

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8. Referring to claims 3 and 27-28, Tsuei has taught the address inquiry system wherein the database relationally stores a plurality of old addresses and one new address (Tsuei figure 3, elements 340, 342, 344, 350, 352, and 354).

9. Referring to claims 4, 13, 16-18, 29, 34, Tsuei has taught the address inquiry system wherein the address disclosing condition is allowed to be set on each of the plurality of old addresses in the database (Tsuei figure 3, elements 350, 352, and 354; and column 6, line 66 – column 7, line 8).

10. Referring to claims 5, 20-22, 37-41, Tsuei has taught the address inquiry system wherein the old address and the new address each include an electronic mail address or various other types of addresses (Tsuei figure 3, elements 340, 342, 344, 350, 352, and 354 where the phrase “at least one of” requires only one item from the list.)

11. Referring to claims 6, 9, 19, 36, Tsuei has taught the address inquiry system further comprising a means for informing the inquirer of the new address of a predetermined sort according to the sort of the old address included in the inquiry sent from the inquirer (Tsuei column 7, line 19 – column 8, line 4 includes multiple means for accomplishing this task.).

12. Referring to claims 7, 33, Tsuei has taught the address inquiry system wherein the inquiry sent from the inquirer includes a message text sent from the inquirer to the user, the system, further comprising a means for sending the message text to make the user confirm whether the new address is disclosed according to the selection of the user (Tsuei column 6, lines 45-54).

13. Referring to claims 14-15, 30-32, Tsuei has taught the system wherein the attribute information includes a profile of the inquirer (Tsuei figure 3, elements 350, 352, and 354; and column 6, line 66 – column 7, line 8).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


- a. Nielsen U.S. Patent Number 6,405,243
- b. Reilly U.S. Patent Number 6,427,164
- c. Shaffer et al. U.S. Patent Number 6,373,940

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott M. Collins whose telephone number is 571.272.3934. The examiner can normally be reached on Mon.-Fri. 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B Harvey can be reached on 571.272.3896. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smc
November 23, 2004


JACK B. HARVEY
SUPERVISORY PATENT EXAMINER